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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hansen Yuan

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EXAMINER

COMSTOCK, DAVID C

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3733

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/091,708	Applicant(s) YUAN ET AL.	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-83 and 85-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-83 and 85-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11 September 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 81, 85-89, 91 and 95-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson (US Patent Number 6,110,172), previously cited by examiner.

Jackson disclose a device for securing a spinal rod to the spine comprising a head portion defining a central axis extending from an upper end to a lower end of the head portion, wherein the head portion has a channel extending therethrough oriented perpendicular to the central axis and configured to receive a spinal rod, wherein the head portion has opposed walls with arcuate engagement slots, e.g. 22 and 23 (see figure 2) and a seat (see figure 2) a two-part locking cap including an upper portion/first portion (see figure 4) having opposed arcuate inclined engagement flanges, e.g. 40 and 41, (see figure 4) cammingly engageable with an interior surface of the head portion (see figures 1 and 7) and a lower portion/second portion, (see figure 4) having an elongated recess, e.g. 68, for engaging an exterior surface of a spinal rod received by the channel (see column 5, lines 32-34), wherein the upper portion and the lower portion of the locking cap are mechanically coupled together, e.g. by threads, by an

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arcuate axial post, e.g. 4, wherein the upper portion of the locking cap is capable of being rotated relative to the head portion (see column 5, lines 26-28), wherein the first portion of the locking cap is located above the second portion of the locking cap as the locking cap moves from an unlocked to a locked position, wherein the first portion of the locking cap is spaced from the spinal rod when the locking cap is in the locked position (see figure 7), and a fastener portion, e.g. 2, depending from the lower end of the head portion, wherein the head portion is formed monolithic with the fastener portion (see figure 1). With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Jackson, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 82, 92-94 and 98-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US Patent Number 6,110,172), previously cited by examiner in view of Puno et al. (US Patent Number 5,360,431), previously cited by examiner

Jackson discloses the claimed invention (see above) except for the fastener portion being movable relative to the head portion and the fastener including a spherical head and a threaded body depending from the spherical head. Puno et al. disclose a device for securing a spinal rod to the spine comprising a movable fastener portion, e.g. 21, including a spherical head, e.g. 30, and a threaded body, e.g. 21, depending from the spherical head (see figures 2-7) and teach that the screw is separate from the anchor seat in order to provide limited motion between the anchor seat and the vertebrae and to act as a shock-absorber (see column 3, lines 64-68 and column 4, lines 1-5). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Jackson with the fastener portion being movable relative to the head portion and the fastener including a spherical head and a threaded body depending from the spherical head, in view of Puno et al., in order to provide limited motion between the anchor seat and the vertebrae and to act as a shock-absorber.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 71-83 and 85-106 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,565,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences amount to minor changes in phraseology and arrangement of claim limitations.

Response to Arguments

Applicant's arguments filed 05 August 2009 with respect to claims 71 and 81 have been considered but are not fully persuasive.

Regarding claim 71, Applicant's argument that the device of Jackson does not show a locking cap including an upper portion and lower portion coupled together by an axial post that facilitates relative rotational movement of the upper portion relative to the lower portion, etc. (see Remarks, page 4), is found to be persuasive. However, while

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claim 81 requires two “portions” of the locking cap that must be capable of rotating with respect to each other, it does not explicitly require a two-part design. Otherwise, claim 83, which further recites a “two-part” locking cap would be meaningless. It is noted that the cap of Jackson comprises the two portions noted in the rejection and the two portions are at least capable of relative rotation. For example, if one portion were rotated about a fixed axis, the other portion, which is offset from the first, would rotate about the first portion and axis. Therefore, Examiner would agree that an amendment incorporating the limitations of claim 83 into claim 81 would accord with Applicant's arguments and would render claim 81 and the claims dependent thereon allowable over Jackson. Such an amendment would be entered after final as it would not necessitate an updated search.

Allowable Subject Matter

Examiner notes that Claims 71-80 and 101-103 will be allowable upon the filing of a terminal disclaimer to obviate the double patenting rejection. Moreover, as claim 83 explicitly recites among its other limitations a two-part cap, and as this is not found in Jackson, as argued by Applicant, an amendment which incorporates the limitations of claim 83 into claim 81 will render all of claims 81-83, 85-100 and 104-106 allowable over Jackson. In such a case, these claims will also be allowable upon the filing of the terminal disclaimer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733